

Remarks

Applicant contends that there is no contact lens case or prior art that teaches or claims a mirror embedded in one of the caps. While applicant concurs with Examiner that there are mirrors embedded in cases for contact lens cases or makeup cases, Applicant respectfully disagrees that the cited prior art teaches or make obvious the present invention.

Claims 6-9 represent similar embodiments of the case as Claims 1-5, but instead of gluing the mirror into the basin, the mirror is held into the basin by the basin walls. In other words, the mirror snaps into the basin and the basin itself holds the mirror in place by compression forces of the molded plastic basin walls and case. For manufacturing and cost reasons this is the way the case is made now and sold. The mirror can be snapped into the basin, forced out of the basin, and then snapped back into the basin.

In the Specification

Applicant respectfully submits the following changes to be made in the application, on line 5 of paragraph 25, "The opposite cap 14" should read "The opposite cap". On line 8 and line 9 of paragraph 27 "contact lens cases' cap 12" should read "contact lens cases' cap 13."

Rejection Under 35 USC 112

Claims 1-11 stand rejected under 35 USC 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter of applicant's invention because the term "flange" in Claims 1-11 is not appropriate. Withdrawal of this rejection is respectfully requested.

Applicant concedes that either "cover" or "cap", is more descriptive of the element referred to as a "flange". Applicant has adopted Examiner's suggest to change the terminology to "cap" or "cover" by amending the claims to replace the term "flange" with the term "cap".

Claim 9 stands rejected under 35 USC 112, second paragraph because the phrase “by the folding toward center of the additional depth of the said basin over the depth of said reflective surface” has no definite meaning and it is unclear how the basin or the reflective surface fold toward the center of the additional depth of the basin.

5 Claim 9 has been amended to read as “said reflective surface is secured within said basin by the compression forces toward center of the depth of said basin against the depth of said reflective surface. As described, the contact case of the present invention is molded out of a flexible a polymer (paragraph 12). The reflective surface can be secured to the basin in a number of ways, one embodiment would be to glue the reflective lens in the basin or on top of a cap
10 which is flat but has no basin. The present invention eliminates the need to use a glue or other adhesive product, instead teaching a cap with a basin that has a larger depth than that of the reflective surface which is to be inserted. The reflective surface is inserted into the basin and is held in place by the compression forces exerted against it by the basin walls. During the manufacturing process the reflective surface, which is slightly smaller than the basin opening, is
15 forced into the basin under pressure. Once located in the basin, the reflective surface’s smaller depth allows it to be held in place by the compression forces of the polymer, which is slightly stretched.

 The amended language of claim 9 now clarifies the “folding”, which is actually compression, and “depth” terms, which are likely what has led to Examiner’s confusion on how
20 the basin or reflective surface “folds”. If examiner is still unclear of the claim language or would like to discuss a proposed amended claim language to overcome this rejection, Examiner is invited to contact Application to conduct a phone interview. Withdrawal of this rejection is respectfully requested.

Claim 6 stands rejected under 35 USC 112, second paragraph because the phrase “each said reservoir” is not appropriate if there is only one reservoir. The claim has been amended to replace the phrase with “each reservoir”, as the claim earlier recited and specifies “at least one reservoir”. Withdrawal of this rejection is respectfully requested.

5 In the specification and claims, the term ‘reservoir’ refers to the place where the contact lens case is stored in fluid while the term ‘basin’ refers to the place where the mirror is held.

Rejections Under 35 USC 102

Claims 1-11 stand rejected under 35 USC Section 102(b) as being described previously in view of *Speshyock et al.* (U.S. 3,211,281) hereafter referred to as ‘281, claims 1-4 or anticipated by
10 ‘281, claims 5-11. With respect to claims 1-11, Examiner cites ‘281, stating that is discloses a contact lens case comprising:

1. base (verified by Fig 1, ‘281, item 1);
2. cover (verified by Fig 1, ‘281, item 2);
- 15 3. at least one reservoir on the top side of the base having an outer surface (verified by Fig 2, ‘281)
4. cover having its own outer surface and attachable to the base via its own threads (verified by Fig 1, ‘281 item 18);
- 20 5. a reflective surface covering said outer surface of said cover(verified by Fig 1, ‘281, item 5); and
6. said cover having a basin and the reflective surface has a depth less than the basin depth.

The sixth element in Applicant’s claims is not taught, suggested, or anticipated by ‘281.

Examiner provides no citation to the teaching of a cover or cap having a basin wherein the
25 reflective surface has a depth less than the basin depth in ‘281. ‘281 teaches a mirrored case that holds a contact lens case (see column 3, line 48), it is *not* a mirrored contact lens case but a case for a contact lens case.

Applicant would like to emphasize the differences between the present application and the teaching of '281. Specifically, the present application is narrowly focused on a basin on a cap that covers the area for storing a contact lens and is not a case for a contact lens case as that taught by '281. Applicant's invention incorporates a reflective surface on a contact lens case in a unique and non-obvious way, while '218 merely teaches a case comprising two parts, which allow for the storage of a contact lens case and other materials, with one part of the case having a reflective surface. There is no mention of teaching in '218 of how to secure the reflective surface to a case, and '281 does not teach the use of a basin or any specific size.

In emphasizing the differences between the two cases, Applicant also points to Appeal No. 98-0459¹ wherein the Board of Patent Appeals and Interferences reversed Examiner's rejections in a different application, which were based on a similar difference. In that case the Board held that the Applicant's invention was not simply two physically separate and distinct structural entities, but a new arrangement having an additional exterior storage compartment. Here, a similar confusion is occurring, wherein Examiner is not appreciating the difference between a combination of cases use for storing contact lenses and other materials, and a single contact lens case with a reflective surface, that is attached in a novel and non-obvious manner.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration and it is not enough that the prior art reference discloses all the claimed elements in isolation, rather anticipation requires disclosure as arranged in the claim.

See. *W.L. Gore & Associates v. Garlock, Inc.* Further anticipation will not be found when the prior art is lacking or missing a specific feature or structure of the claimed invention. Here, as

¹ Ex parte Gaylord E. Tohill, Jr and Steve E. Henschel, Appeal No. 98-0459, Application 08/658, 719. Reversing Examiner's rejections based on obviousness that the prior art taught a contact lens storage compartment having at least one additional lens storage compartment "exterior" to the covered main storage compartment.

previously discussed, '281 does not disclose the use of basin to secure the mirrored surface using compressive pressure from the side wall of a basin as claimed by Applicant.

Also, "said cover having a basin and the reflective surface has a depth less than the basin depth" is not found in the prior art. Thus, anticipation can *not* be found and the Examiner will be required to allow this claim or change the basis or rejection by combining this application with another prior art document to show obviousness under §103.

Additionally, to establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill". See *Continental Can Co. USA v. Monsanto Co.* When an examiner relies on inherency, it is incumbent on the Examiner to point to the page and line of the prior art that justifies this rejection. Here, Examiner has made no such citation.

Applicant has amended independent claims 1 and 6 to include the sixth element originally found in dependant claim 8, described above, which is not taught in the prior art.

With respect to Claims 5-11 as anticipated under 102(b), and rejected in the alternative under 103(a). Examiner did not list in either 102 rejection for claims 1-4 or 5-11 that the reflective surface was adhered to the basin per claim 5 but alleges that it is obvious to secure the mirror to prevent it from inadvertent removal from the basin. Applicant rebuts Examiner's contention that securing the mirror would be obvious and requests that examiner provide a citation teaching this element and means for attachment.

Withdrawal of these rejections is respectfully requested.

Rejections Under 35 USC 103

A prima face case of obviousness is established when an examiner provides:

1. one or more references
2. that were available to the inventor and
3. that teach
4. a suggestion to combine or modify the references,
5. the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

Accordingly, an applicant who is able to prove that the Examiner has failed to establish any one of these elements will prevent the prima facie case of obviousness from being established.

Here, as in the rejections under 102, Examiner's basis is unsupported as well. Specifically, Examiner states "the mirror appears to be attached to the basin", failing the 3rd element of a proper case of obviousness, that the prior art teach the element, even conceding that "if it is not attached, it would have been obvious to secure the mirror to prevent it for inadvertent removal." How does the Examiner know that '281 didn't contemplate removal? The Examiner can *not* claim it is obvious under '281 to attach the mirror due to its lack of teaching and the possibility of a desirable effect for removability.

Additionally, the Examiner's position fails the 4th element of a case for obviousness. Generally, one prior art reference alone is not typically used to support an obviousness rejection because, by definition, more than one source of information must support such a rejection.

When analyzing the patentability of claims against the standard of 103, one must analyze from the perspective of at the time the invention was made and not use hindsight. See *In re Fritch and Loctite Corp. v. Ultraseal Ltd.* Case law makes it clear that the best defense against hindsight is rigorous application for a showing of the teaching or motivation to modify.

ACS Hospital holds that an Examiner may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention. See also *In re Dow Chemical Co.* Here '281 refers to a 'cover.' The examiner refers to this cover containing a

mirror. In Fig. 2 of '281, the cover that '281 refers to is removed, showing the 'lens holding portion.' The 'lens holding portion' is the contact lens case. In the first claim of '281, it also states the invention has a contact lens holding means, which includes a base and cover that can have a mirror, and the invention has a contact lens storage means, which is the case in the present invention. They are two separate and distinct parts of '281.

Column 3, lines 70-75 of '281 discusses the cover; base; and fluid-containing compartments bounded by bottom, sidewall and removable caps. The cover is separate from the removable caps of the fluid containing compartments.

Column 5, line 13 of '281 states that "all the embodiments utilize the same lens holding cap element." This lens holding cap element is not mirrored. The cover can be mirrored. The word "mirror" appears only once in 281 in column 3 line 49.

Now referring to Examiner's Claim Rejection Under 102. This portion of the rejection cannot be found in '281. The examiner's description in the OA closely follows Applicants description on page 2 of the present application and is not supported by '281 or any other cited reference. The mentioned mirrored 'cover' in Examiner's rejections cannot possibly refer to '281 as the 'cover' in '281 is not a threaded connection to the base. The present invention describes a mirrored cover (cap) for a contact lens case. '281 merely describes a mirrored cover for the cover for a contact lens case.

Common Knowledge and Common Sense is also not sufficient to supply motivation for modifications. The factual inquire to modify must be based on objective evidence of records. *Ex parte Humphreys* holds that when an Examiner does not provide specific reasons to support the obviousness rejection, they have failed to establish the prima facie case of obviousness. Here

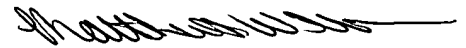
Examiner states the specific reason to support the modification is to eliminate unwanted removal from the basin, but provides no teaching on whether removal is or was desired.

Conclusion

For all the reasons advanced above, Applicant respectfully submits that the application is in
5 condition for allowance and that action is earnestly solicited.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely.

Respectfully submitted,



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15 Date: December 22, 2005

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